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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/848,581 | 05/03/2001 | James R. Durkee | 2000-0617 | 8709 |

22045 7590 05/22/2006

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2623 | |

DATE MAILED: 05/22/2006

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/848,581
Filing Date: May 03, 2001
Appellant(s): DURKEE ET AL.

John R. Buser, ESQ.

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/15/05 appealing from the Office action mailed 4/25/05.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Girard et al (US #5,751,282), Wood et al. (US Pub. #2002/0112007), Knee et al. (US #5,589,892), Nishikawa et al. (US Pub. #2001/0016947) Schneidewend et al (US #6,182,287), & Ozawa et al. (US Pat. Pub. No. 2001/0030959).

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

I. Claims 1-4, 8-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard et al (US #5,751,282) in view of Wood et al. (US Pub. #2002/0112007).

Applicant's Claim 1 recites an interactive television network comprising:

a. a data locator in communication with a set-top terminal, which is used for accessing other interactive television components and for providing broadcast programming

b. one or more memories, *located remotely from the data locator and in communication therewith through a network*, which are accessible by the data locator

c. the data locators containing at least three of the following data:

c(1). Television listings data of past, current, and future scheduled programming

c(2). Programming content data containing audio/video of previously broadcast programming

c(3). Email data containing email for subscribers

c(4). Telephone voice mail info stored on voice mail database.

As to sub-element "a", Girard discloses an interactive television system comprising a head-end (i.e., data locator) coupled to a set-top box, which is used for accessing an electronic programming guide and the corresponding programs stored on the head-end server. (Col. 1, Ln. 5-17). But, Girard fails to teach whether the system can interact with other network components. However, within the same field of endeavor, Wood discloses an interactive system, which can access a variety of remotely located messaging sources (i.e., network components) via the internet (i.e., a network) and can be used in conjunction with WebTV (i.e., television systems). (Pg. 1, Par. [0011 & 0029] & Fig. 1). These network components contain memories needed to store emails, voice mails, etc. (Figs 1 & 2). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system of Girard with the interactive system of Wood in order to provide a system which is capable of accessing a wider variety of network components (i.e. programming guide, internet, and email/voicemail database).

As to sub-element "b", Girard teaches the interactive system contains past, current, and future television listings (Col. 2, Ln. 11-17) and previously broadcasted programming (Col. 2, Ln. 19-22). But, Girard fails to teach a system capable of accessing email and voicemail databases. However, in the same field of endeavor, Wood discloses a system capable of accessing a subscribers email and voicemail messages. (Pg. 3, Par. [0031] & Fig. 4, 5, 6A, &

6B]). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system of Girard with the email and voicemail database accessing capability of Wood in order to provide an interactive system, which allows a user to interact with various network components. (The examiner would like to note that applicant's claim 1 is limited to "at least three" of television listing data, programming content data, email data, and voice mail data. Although it is only necessary to cite three of the limitations as the basis of an obviousness rejection, the above citations contain all four).

Claims 8 and 9 are means-plus function and method claims, respectively, which correspond to the apparatus claim 1. Accordingly, they are analyzed and rejected as previously discussed.

Applicant's Claim 2 recites the network of Claim 1, wherein the television listing data includes the title, channel, time, duration, content description, rating, category, and another air time. As mentioned above, Girard and Wood contain all limitations of applicant's Claim 1 and Girard further discloses the programming guide contains the title (Fig. 2), channel (Fig. 2), duration (Fig. 2), content description (Fig. 2), category (Fig. 4), and another air-time (Col. 1, Ln. 38-43—since a movie can be shown every 2 hours, it is inherent that the guide contain the alternate show times). But Girard fails to specifically disclose whether the guide contains the program rating. However, providing a program rating is an obvious variant of Girard's programming guide. Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to modify the programming guide of Girard to also display the program rating in order to provide a more detailed listing.

Applicant's Claim 3 recites the method of Claim 1, wherein the programming data includes at least one of closed caption information, speech transcription, video information, program title, program rating, program category, and another air time. (Note: The PTO considers claims containing the "at least one of" language to be anticipated by prior art containing any one of the subsequent limitations.) As discussed above, Girard and Wood contain all limitations of applicant's Claim 1 and 2. Since a number of limitations within Claim 2 are listed in Claim 3 also, Claim 3 is analyzed and rejected as previously discussed under Claim 2. (The examiner also notes that Wood discloses a method whereby a segment of the voicemail message is converted to text. (Par. [0056], [0057] & Fig. 6D)).

Applicant's Claim 11 is a method claim, which contains a combination of limitations from apparatus claims 2 and 3. It is analyzed and rejected as previously discussed therein.

Applicant's Claim 4 recites the method of Claim 1, wherein the programming content data includes at least one of metadata and XML data. (Note: This claim contains the "at least one of" language, so the above interpretation applies here also) As discussed above, Girard and Wood contain all limitations of applicant's Claim 1, and Girard further teaches the programming guide contains information such as the program title, category, etc. (Fig. 2). Since applicant's specification describes metadata as information such as the program title (Spec. Pg. 1), Claim 4 is analyzed and rejected as discussed under Claim 2.

Applicant's Claim 10 recites the method of Claim 9, further comprising:

a. recording at least a portion of the broadcasting programming in memory during the broadcast

b. receiving a request to rebroadcast the programming from a subscriber

c. retrieving the program from memory

d. and replaying the program to the subscribers.

As discussed above, Girard and Wood contain all limitations of applicant's Claim 9, and Girard further discloses a method in which the head-end stores the programs as they are transmitted in real time so that they can be added to the previously played program database. (Col. 2, Ln. 18-22). Once this is done, the user can request the previously broadcasted program and it is retrieved and replayed by the user's set-top box. (Col. 2, Ln. 30-35). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combination of Girard and Wood to also contain the simultaneous storage/replay teaching of Girard in order to provide the user with the ability to replay previously broadcasted programs.

Applicant's Claim 12 recites the method of Claim 9, wherein the forwarding step includes providing only a portion of a program to the network subscriber. As discussed above, Girard and Wood contain all limitations of applicant's claim 9, and Girard further discloses a method by which a clip of a future program (i.e., portion of program) can be supplied to a subscriber. (Col. 2, Ln. 35-40). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to further modify the combined teachings of Girard and Wood to also include the clip providing capability of Girard in order to allow the user view clips of programs instead of viewing them in their entirety.

Applicant's Claim 13 recites the method of Claim 12, wherein the program portion includes only a portion of the frames of the program. As discussed above, Girard and Wood contain all limitations of applicant's claim 12 based upon Girard's disclosure of a method by

which a clip of a future program (i.e., portion of program) can be supplied to a subscriber. (Col. 2, Ln. 35-40), which also serve the basis of Claim 13's rejection. A clip of a program can be either a program portion or portions of the frames of a program. Accordingly, Claim 13 is analyzed and rejected as previously discussed under Claim 12.

Applicant's Claim 14 recites the method of Claim 9, wherein the forwarding step includes providing a location indicator of the at least three types of data to the network subscriber. As discussed above, Girard and Wood contain all limitations of applicant's Claim 9 and they further contain the following: Girard lists the broadcast channel (i.e., location) of the past, current, and future programming (Fig. 2). Wood discloses a method by which the source of the email/voicemail messages is displayed. (Fig. 6A/6E). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combined teachings of Girard and Wood to further include location indicators of the messages in order to inform the user of the identification of the sender.

Applicant's Claim 16 recites the method of Claim 9, further comprising receiving an email message from subscriber including the location indicator and delivering the message to a second network subscriber. As discussed above, Girard and Wood contain all limitations of applicant's Claim 9, and Wood further teaches receiving an email message from subscriber containing a location indicator (i.e., sender) and delivering it to a recipient (which could be anyone including a second network subscriber). (Par. [0072] and Fig. 6E). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the joint teaching of Girard and Wood to further include the location indication capability of Wood in order to allow subscribers to send emails.

II. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Wood as applied to claim 1 above, and further in view of Knee et al. (US #5,589,892).

Applicant's Claim 5 recites the network of Claim 1, wherein the one or more memories further include:

a. billing data for subscribers

b. help data for subscribers

c. personal information for subscribers

d. calendar information for subscribers

e. and, financial information for subscribers

As discussed above, Girard and Wood contain all limitations of applicant's Claim 1, but fail to discloses the limitations recited in Claim 5. However, in the same field of endeavor, Knee discloses an interactive programming guide containing the customer's billing data (Fig. 29), help data (Col. 13, Ln. 33-59; Fig. 36D), personal information (Fig. 29), calendar information (Col. 16, Ln. 51-65; Fig. 13), and financial information (Col. 22, Ln. 5-13; Col. 37, Ln. 41-51). The examiner interprets the "calendar information" limitation to be any data pertaining to the date or time of a program in relation to a user's schedule. Knee's method allows a user to set a reminder to be displayed on the specified time and day entered by the user. (Col. 16, Ln. 51-65; Fig. 13). Therefore, in essence the user is allowed to set reminders on his or her calendar, to inform the user of certain programs which will be aired. Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system

of Girard and Wood with the data system of Knee in order to provide an efficient method of billing, data storage, trouble shooting, and a more user friendly system.

Applicant's Claim 6 recites the network of Claim 4, wherein the personal information includes payment method, credit card information, debit card information, subscriber's name, telephone number, address, and a history of purchases. As discussed above, Girard and Wood contain all limitations of applicant's Claim 4, but fail to disclose the limitations of claim 5. However, within the same field of endeavor, Knee discloses an interactive network containing payment method information (Fig. 43C), credit card information (Col. 37, 42-43), subscriber name (Fig. 29), subscriber address/telephone number (Col. 37, Ln 42-43), and subscriber purchase history (Col. 22, Ln. 5-13). Although Knee does not explicitly state that debit cards can be used, this limitation is an obvious variant to a credit card. Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system of Girard and Wood with the personal information teaching of Knee in order to provide a more efficient billing system and to provide up to date purchase information to a user.

III. Claim 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Wood as applied to claim 1 above, and further in view of Nishikawa et al. (US Pub. #2001/0016947).

Applicant's Claim 7 recites the network of Claim 1, where in the television screen includes a title safe portion and an action safe portion. As discussed above, Girard and Wood contain all limitations of applicant's Claim 1, but fails to disclose a television screen containing

an action and title safe portion. However, within the same field of endeavor, Nishikawa discloses such an interactive screen. (Fig. 18). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system of Girard and Wood with the interactive screen of Nishikawa in order to provide the user with a portion of the screen dedicated to entering user inputs.

Applicant's Claim 17 recites the method of Claim 9, further comprising displaying a virtual keyboard, the keyboard being located entirely in the title safe portion of the television screen and receiving from the network subscriber a signal corresponding to the virtual keyboard. As discussed above, Girard and Wood contain all limitations of applicant's Claim 9, but fail to teach the use of a virtual keyboard. However, in the same field of endeavor, Nishikawa discloses the use of a virtual keyboard in which the user can input terms. (Par. [0085] & Fig. 18). Thus, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system of Girard and Wood with the virtual keyboard on Nishikawa in order to provide the user with a method of inputting search terms.

IV. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Wood as applied to claim 1 above, and further in view of Vallone et al. (US #6,642,939).

Applicant's Claim 15 recites the method of Claim 9, wherein the location indicator is a pointer to a time stamp in a multimedia stream. As discussed above, Girard and Wood contain all limitations of applicant's Claim 1, and Girard further discloses the use of pointers, which are used to access media streams and/or segments of media streams contained on the EPG. (Col. 6, Ln. 59-67 – Col. 7, Ln. 1-10). But, Girard and Wood fail to specifically disclose the use of time

stamps embedded within the media streams. However, within the same field of endeavor, Vallone discloses a method in which media streams are embedded with time stamps that enable the system to locate any spot within a program. (Col. 6, Ln. 8-15). +Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the pointer teaching of Girard with the time stamp teaching of Vallone in order to provide the user with a method of accessing programs dependent upon time stamps embedded in the program.

V. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Wood as applied to claim 9 above, and further in view of Bertram. (US #5,606,374).

Applicant's Claim 18 recites the method of Claim 9, wherein the broadcast programming includes a network address and further comprises:

a. rendering a bug on the television screen

b. receiving a signal corresponding to the bug

c. and sending a signal to the network address in response to the user's input.

Applicant has defined "bug" to be "a single graphic overlay on the video stream" and has stated that the "network address" can be a URL, pointer to another channel, or the like. (Spec. Pg. 5, Ln. 3-5). As discussed above, Girard and Wood contain all limitations of applicant's Claim 9, but fail to specifically disclose the limitations of claim 18. However, within the same field of endeavor, Bertram discloses an interactive menu overlaying a video stream (Fig. 13-16). Through the use of a remote, the user generates a signal by clicking one of the graphical images, which will send a response up channel, via a distribution link or telephone line, to the network

address of any number of interactive networks. (Col. 4, Ln. 24-41; Col. 40, Ln. 20-41). (The examiner notes the citations do not specifically discuss a network address assigned to the network components, but this portion of the claim is contained in the preamble and is not considered a limitation of the claim. In the event applicant chooses to amend claim to include it as a limitation, it would be analyzed and rejected under Schneidewend et al US #6,182,287 as under claim 19 below.) Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive system of Girard and Wood with the graphical overlay of Bertram in order to provide the user with a more convenient method of accessing interactive services.

VI. Claims 19, 20, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneidewend et al (US #6,182,287) in view of Bertram and further in view of Ozawa et al. (US Pat. Pub. No. 2001/0030959).

Applicant's Claim 19 recites an interactive television network comprising:

a. providing a multimedia broadcast stream to a set top terminal *from a head-end unit*, the broadcast stream containing a network address

b. rendering a first picture on a television containing at least one bug

c. receiving a signal from a subscriber relating to the bug

d. *accessing data stored on a database located remotely from the head-end unit in response to receipt of the signal and according to the network address, the network address being associated with the database located remotely from the head-end unit; and*

e. *providing the remotely located data from the remote database to the head-end unit for delivery to the set-top terminal.*

As to sub element "a" and "d", Schneidewend discloses a method of using an interactive system, which provides multimedia broadcast programming containing various network addresses associated with remote systems (Col. 2, Ln. 17-31 & Figs. 3 & 4). The network address would provide a link to some database located remotely from the head-end. (such as information related to a movie as disclosed at Col. 5, Ln. 67 thru Col. 6, Ln. 1-3). Moreover, as shown in Fig. 4, the user can access a number of storage databases including phone, email, etc, which would also be located remotely from the head-end.

It is inherent the system of Schneidewend contain a head-end unit because (as discussed above under "Response to Arguments") CATV systems must contain such a unit for processing the signals in preparation for transmission. But, Schneidewend fails to teach sub-elements b, c, and e. However, within the same field of endeavor, Bertram discloses a method by which a graphic image is overlaid onto the video stream, a signal is received from the user in relation to the graphic overlay, and the system performs an action in response to the signal (i.e., elements b and c). (Fig. 13-16; Col. 40, Ln. 20-41).

As to sub-element e, Ozawa et al discloses a similar system in which various remote devices can be accessed and provided to the head-end unit for delivery to the set-top box. (Par. [0026] and Fig. 1). [**NOTE**: Due to applicant's amendment adding sub-element "e", the Examiner was required to perform a supplementary search, which resulted in the application of the Ozawa Reference]. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the interactive system of Schneidewend with

the graphic overlay of Bertram and the head-end of Ozawa in order to provide the user with a more efficient way of accessing the interactive services.

Applicant's Claim 20 recites the method of Claim 19, *further comprising* rendering a second picture on the television presenting information related to the bug *and the remotely located data*. As discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of Claim 19, and Bertram further discloses that information relating to the graphical overlay is displayed after a user selects the overlay (i.e., rendering a second picture). (Fig. 14-18). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combined teachings of Schneidewend, Bertram, and Ozawa to further include Bertram's graphical overlays in order to provide the user with a more efficient method of using the interactive services. Moreover, the bug of the combined system would be associated with presented information and the remotely located data because, of course, the system is meant to retrieve such data. For example, the user would click on the bug and be given access to various databases and further information which would be presented on the screen. (Fig. 4 of Schneidenwend shows such a layout).

Applicant's Claim 21 recites the method of Claim 19, where in the network address is at least one of a URL and a channel. As stated earlier, the "at least one of" language is rendered obvious if any one of the subsequent limitations is contained within the prior art. Also as discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of applicant's Claim 19, and Schneidewend further discloses a URL and channel to designate interactive services. (Fig. 3). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combined teachings of Schneidewend, Bertram,

and Ozawa to further include the URL and channel designations of Schneidewend in order to provide an interactive network capable of accessing the internet and various channel broadcasts.

Applicant's Claim 26 recites the method of Claim 19, further comprising connecting the subscriber with the vendor. As discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of Claim 19. It is obvious that in order to receive any broadcast, the subscriber must be connected to the vendor (i.e., content provider, etc.). Thus, it was obvious to one ordinarily skilled in this art at the time of applicant's invention that in order to combine the teachings of Schneidewend, Bertram, and Ozawa to provide an interactive television system, the system must be connected to the vendor.

VII. Claims 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneidewend in view of Bertram and Ozawa as applied to claim 19 above, and further in view of Nishikawa.

Applicant's Claim 22 recites the method of Claim 19, wherein the multimedia broadcast stream includes an advertisement from the vendor. As discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of applicant's Claim 19, but fail to teach whether the multimedia broadcast stream can contain advertisements from a vendor. However, within the same field of endeavor, Nishikawa discloses a method by which a service provider is able to email advertisements to a user. (Pg. 7, Par. [0075]). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the joint teachings of Schneidewend, Bertram, and Ozawa with the advertisement teaching of Nishikawa in order to provide a convenient avenue for a service provider (i.e., vendor) to communicate

and/or advertise to the users. (The examiner notes that applicant refers to vendors and service providers as entities which "...*can be* retailers offering ...goods..." and "...providers of pay-per-view services...", respectively. (Spec. Pg. 13, Ln. 19-21). Therefore, applicant may have sufficiently distinguished the two. However, the examiner also considers a vendor to be an obvious variant of a service provider and, if needed, could reject accordingly.)

Applicant's Claim 23 recites the method of Claim 22, wherein the bug is rendered as a request to purchase a good or service in the advertisement. As discussed above, Schneidewend, Bertram, Ozawa, and Nishikawa contain all limitations of Claim 22. Nishikawa further discloses the use of a purchase icon appearing adjacent to programs desired to be purchased, but fails to disclose that it can be graphically overlaid onto a video stream. (Pg. 1, Par. [0011]). However, as discussed earlier, Bertram does teach the use of graphical images (i.e., bugs) overlaid onto a video stream. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to further modify the combined teachings of Schneidewend, Bertram, Ozawa and Nishikawa to also include a bug used to make purchases in order to provide the user with a convenient method of interactive purchasing.

Applicant's Claim 24 recites the method of Claim 19, wherein the second picture includes a confirmation request. As discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of Claim 19, but fail to disclose the use of a confirmation request. However, and Nishikawa further discloses that after the record icon is selected, the user is visually presented with a pull-down screen containing cost, date, and time of the program purchased or to be purchased and a review purchases icon allowing the user to review past purchases. (Pg. 1, Par [0011]). But, Nishikawa fails to specifically teach the use of a

confirmation request of the purchase. However, a confirmation request is an obvious variant to the Nishikawa's pull down and review purchases icon. Thus, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to modify the purchase/review purchases teaching of Nishikawa to also include a purchase confirmation in order to provide the user with a second chance to further consider his or her purchase.

VIII. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneidewend in view of Bertram and Ozawa as applied to claim 19 above, and further in view of Knee.

Applicant's Claim 25 recites the method of Claim 19, wherein the rendering step includes accessing a database containing subscriber's personal information, the database being maintained by the network operator, and including the personal information in the purchasing information. As discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of applicant's Claim 19, but fail to disclose any billing method. However, within the same field of endeavor, Knee discloses a network system, which has a database containing subscriber's personal information. (Col. 22, Ln. 5-13). After a subscriber makes a purchase, his or her personal information can be automatically inputted onto the billing statement. (Col. 37 Ln. 41-51). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive television network taught by Schneidewend, Bertram, and Ozawa with the network database of Knee in order to provide an easier, more efficient method of billing.

Applicant's Claim 27 recites the method of Claim 19 further comprising prior to the rendering of the second picture:

a. retrieving a subscriber's personal information from memory

b. completing at least one field of the electronic order form using the subscriber's personal information, wherein the partially completed order form is presented to the subscriber

As discussed above, Schneidewend, Bertram, and Ozawa contain all limitations of applicant's Claim 19, but fail to disclose any billing method. However, within the same field of endeavor, Knee discloses a network system, which has a database containing subscriber's personal information. (Col. 22, Ln. 5-13). After a subscriber makes a purchase, his or her personal information can be automatically inputted onto a billing statement. (Col. 37 Ln. 41-51). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the interactive television network taught by Schneidewend, Bertram, and Ozawa with the network database of Knee in order to provide an easier, more efficient method of purchasing and/or billing.

**(10) Response to Argument**

**I. RESPONSE TO APPELLANT'S ARGUMENTS**

Appellants argue there is no motivation to combine the Girard and Wood references and that even the improper combination of said references fails to teach each element recited in the independent claims. The Examiner disagrees and will show how the Office was reasonable in establishing a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. First there must be **some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one or ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**1. Suggestion and Motivation to Combine**

The Examiner has provided a sufficient suggestion to combine the references. In Paragraph 29 and Figure 1, Wood discloses his system can be used in conjunction with a television system (i.e., WebTV). This provides a clear suggestion to combine the cited references.

However, Appellant still argues one of ordinary skill would not logically determine that this reference to WebTV implies the systems can be integrated. (Appl. Response, Pg. 6). To support this argument, Appellant implies that WebTV cannot be integrated into a cable television network as recited in the claimed invention. This argument fails in two aspects. First, a "cable" (i.e., wired) television system is not claimed. Second, Wood further teaches the communication links can be any suitable medium, including landlines and wireless connections. (Par. [0030] & Fig. 1).

The Appellant also argues Wood provides no suggestion that it can be used in conjunction with a broadcasting system. (Appl. Response, Pg. 8). However, as previously discussed, Wood does in fact teach the system can be used in conjunction with a WebTV system (i.e., broadcasting system). Appellant may further argue that a WebTV system does not "broadcast." In rebuttal, the Examiner argues the term broadcasting simply means to send data to 1 or more locations over a network—which describes a WebTV system. Accordingly, the systems can be used in conjunction.

The Examiner has cited sufficient motivation to combined the references. However, Appellant argues there is no motivation to combine Wood and Girard because the Girard patent has no desire to collect messages from multiple sources and Wood has no desire to deliver video on demand. (Appl. Brief, Pg. 6). In rebuttal, Paragraphs 5 and 9 of Wood discuss the need for a system that organizes and presents messages to users, which are retrieved from various sources. Wood goes on to discuss how similar systems provide affordable avenues for keeping people in contact with each other. This, at the very least, would be sufficient motivation to combine this system with one such as Girard's, especially when considering Wood's teaching that his system can be used in conjunction with television systems. Such a combination would expand Girard's Video on Demand system with one that also compiles and organizes messages, thus providing a more centralized multimedia interface.

Appellant goes on to argue the systems of Girard and Wood are nonanalogous because Girard is incapable of interacting with other network components. Appellant cite the Examiner as stating, the Girard patent "fails to teach whether the system can interact with other network components...". (Page 5 of Appellant's Brief). However, Appellant takes the Examiner's

statement out of context. This refers not to whether the system is *capable* of communicating with other network components, but rather, whether Girard's system discloses the use of other network components. Although Girard does not discuss the use of other network components, it is still capable of being used in conjunction with said components.

Girard is capable of communicating with other network components because it comprises a basic client/server architecture. In basic terms, a client/server architecture comprises a client (which is a local computer one uses to request information or applications from a server) and a server (which can be any computer capable of supplying the requested information or application). Dependent upon one's respective location, his or her computer can be considered a client, server, or even a combination of both. This architecture is elementary in computer networks and forms the fundamental basis of telecommunication systems, such as those of Girard and Wood.

Both Girard and Wood comprise client/server architectures and, thus, are analogous. Figure 1 of Girard discloses various *client* set top boxes 38a-d (i.e., cable box, receiver, etc.) which communicate with *servers* 68 and 70. Figure 1 of Wood also discloses various components (i.e., TV, cell phone, work email, personal computers, etc.) which could operate as both clients and servers. Therefore, at the least, Girard and Wood are analogous because their respective client/server architectures could easily be modified and combined by those ordinarily skilled in telecommunications.

Lastly, the state of the art at the time of Applicant's invention shows the combination of a data locator and broadcast programming was well known. Ozawa, US Pat. Pub. No. 2001/0030959 (cited during prosecution) discloses a system comprising a set-top box, which is

capable of providing access to various other remotely located multimedia devices, storage devices, and Internet appliances (such as email). (Par. [0022]). This reference, at the least, is concrete proof that one of ordinary skill in this art at the time of Applicant's invention realized the advantage of combining video systems, such as Girard, and database management systems, such as Woods.

**2. Reasonable Expectation of Success**

There is a reasonable expectation of success because the systems are analogous. As discussed above, those ordinarily skilled in the art realize that client/server communication systems can be combined and expanded as desired. Wood also teaches his system can be used in conjunction with television systems. Therefore, those persons would also realize there is a reasonable expectation of success in the combination.

**3. Prior Art teaches/suggests all claim limitations**

This was discussed in Section (9) above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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May 1, 2006.
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